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10/700,518

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EXAMINER

ROBERTS, JESSICA M

ART UNIT

PAPER NUMBER

2609

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/700,518

Applicant(s)

FUJIYAMA ET AL.

Examiner

Jessica Roberts

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

Claim Objections

1. Claim 6 is objected to because of the following informalities:

- a. Claim 6, as claimed has two steps labeled as step (d).

Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. **Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over**

Matsumoto et al, US 7,177,523 in view of Saito et al, US 6,085,020 as applied to

claim 1 and further in view of Okabayashi et al. US 6,751,399.

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5. Regarding claim 1, Matsumoto teaches a first reproducer (recording/reproducing circuit, col. 3 line 35 and 5); a restarter for restarting the timer every time a signal is reproduced automatically (col. 6 lines 52-67 and col. 7 lines 1-8, one function of the system controller is to execute the processing program that is manipulated by the image feed key, once processing has responded to processes of the key timer the image on the display is automatically and continuously renewed, once the number of images recorded and count of images are matched and reset, the program is then advanced to the start of the program); an issuer (system controller, col. 3 line 57-60, and col. 4 line 51-54, and 8) for issuing the image renewal instruction (reproduction switch initiates the program executed by the image feed switch and the image return switch, col. 4 line 12-13 and 60-62)

Matsumoto does not further teach a timer for measuring an image reproducing period; however, Saito teaches to include a timer (edit decision list EDL; col. 2 line 58-61 and 15) for measuring an image reproducing period (start point and end point, col. 8 line 39-40); a second reproducer (hard disk drive, 6) for reproducing one screen of still image from said recording medium (hard disk, col. 3 line 64-64); Therefore, it would have been obvious to one of ordinary skill in the art to modify Matsumoto's system with Saito's technique as disclosed in order to obtain an enhanced system that offers an editing control apparatus that enables editing work to be done in a short time on AV information for news programs and the like, and if there is room to edit again, saves the finished edit information and allows easy checking to see if better editing is possible on the basis of the edit information; in addition to an editing control apparatus equipped

with such an HDD is used for editing AV information, a plurality of events can be played back seamlessly by taking advantage of its fast processing speed.

Both Matsumoto and Saito do not further teach a changer for changing the image reproduction period; however, Okabayashi teaches to a changer (reproduction speed setting section **25**) for changing the image reproducing period in response to a period changing instruction (still picture table **31**) for image recording and reproducing in the same field of endeavor. Therefore, ~~Therefore~~, it would have been obvious to one of ordinary skill in the art to modify Matsumoto and Saito's system with Okabayashi's technique as disclosed in order to obtain an enhanced system that provides a changer and changing instructions for an improved image recording and reproducing device which permits efficient use of an storage area, and which can optimally reproduce both dynamic picture image information and still picture image information stored together in a mixed manner without requiring complex management.

6. Regarding claim 2, the combination of Matsumoto, Saito, and Okabayashi as a whole further teaches wherein the issuer (Matsumoto; system controller, col. 3 line 57-60, and col. 4 line 51-54, and **8**) stops issuing the image renewal instruction (Matsumoto; image feed and image return switch) when the period changing instruction (Okabayashi, still picture table **31**) for extending the image reproducing period.

7. Regarding claim 3, the combination of Matsumoto, Saito, and Okabayashi as a whole further teaches a dial for inputting the changing instruction (Okabayashi, still picture table **31**), wherein said issuer (system controller, col. 3 line 57-60, and col. 4 line 51-54, and **8**) stops issuing the image renewal instruction (reproduction switch initiates

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the program executed by the image feed switch and the image return switch, col. 4 line 12-13 and line 60-62) when a reproducing direction of said plurality of screens of the still image signals is a first reproducing direction and a rotating direction of said dial is a first rotating direction, or when a reproducing direction of said plurality of screens of the still image signals is a second reproducing direction and the rotating direction of said dial is a second rotating direction. However, Okabayashi teaches volume controls (**10b**) for inputting. It is implied from the figure **10b** that the volume control necessitates a direction of rotation in both clockwise and counter counterclockwise direction.

8. Regarding claim 4, the combination of Matsumoto, Saito, and Okabayashi as whole further teaches the first reproducing direction is forward (Matsumoto; forward direction, col. 4 line 19-20) reproducing direction, the second reproducing direction is a reverse (Matsumoto; backward direction, col. 4 line 24-25), the first rotating direction is a counterclockwise direction, and the second rotating direction is a clockwise direction. However, Okabayashi teaches volume controls (**10b**) for inputting. It is implied from figure **10b** that the volume control would necessitates rotation in both clockwise and counter counterclockwise direction.

In re Dailey, 149 USPQ 47 (CCPA 1976)

As noted above, Matzen discloses that the flexible portion of his container is drawn into the rigid to portion, filling the space thereof. Appellants have presented no argument which convinces us that the particular configuration of their container is significant or is anything more than one of numerous configurations a person of ordinary skill in the art

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would find obvious for the purpose of providing mating surfaces in the collapsed container of Matzen. See Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459

9. Regarding claim 5, the combination of Matsumoto, Saito, and Okabayashi as a whole further teaches a recorder for recording said plurality of screens of the still image signals in said recording medium (Matsumoto; col.1 line 52-54)

10. **Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al, US 7,177,523 in view of Saito et al, US 6,085,020 and further in view of Okabayashi et al. US 6,751,399.**

11. Regarding claim 6, which recite the corresponding apparatus steps to the image processing apparatus of claims 1-5. Thus, the analysis and rejection made in claims 1-5 also apply here because the processing apparatus in claims 1-5 would have necessarily performed the steps in claim 6.

Conclusion

12. The referenced citations made in the rejection(s) above are intended to exemplify areas in the prior art document(s) in which the examiner believed are the most relevant to the claimed subject matter. However, it is incumbent upon the applicant to analyze the prior art document(s) in its/their entirety since other areas of the document(s) may be relied upon at a later time to substantiate examiner's rationale of record. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). However, "the prior art's mere disclosure of more than one alternative does not

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constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Roberts whose telephone number is (571) 270-1821. The examiner can normally be reached on 7:30-5:00 EST Monday-Friday, Alt Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vu Le can be reached on (571) 272-7332. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jessica Roberts/



KIEU OANH BUI
PRIMARY EXAMINER